IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
Abbas *et al.*
U.S. Appl. No. 09/903,508

Filed: July 13, 2001

For: **Transformation Systems for Flavinogenic Yeast**

Confirmation No. 3856
Art Unit: 1636
Examiner: Lambertson, D.

Atty. Docket: 1533.0830003/MAC/RGM

#16

Reply To Restriction Requirement

Commissioner for Patents
Washington, D.C. 20231

Sir:

In reply to the Office Action, dated December 17, 2002, requesting an election of one invention to prosecute in the above-referenced patent application, Applicants hereby provisionally elect to prosecute the invention of Group I, represented by claims 1-21, drawn to an isolated polynucleotide sequence, an expression vector containing said sequence, cells containing said vector and methods for transforming the yeast, classified in class 435, subclass 320.1. In addition, Applicants provisionally elect SEQ ID NO. 3. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed. This election is made with traverse.

With respect to the Examiner's division of the claims into four groups and the reasons stated therefor, Applicants respectfully traverse. Even assuming, *arguendo*, that Groups I thru IV represent distinct or independent inventions, Applicants submit that to search and examine the subject matter of the groups together would not be a serious burden on the Examiner, due to the overlap in subject matter. The common subject matter lessens the burden on the Examiner, as there will be significant overlap in the search and examination of a yeast ARS, transformation of yeast cells and yeast mutants. This common

subject matter thereby makes it a simple matter for the Examiner to search and examine publications disclosing the transformation efficiency of yeast cells.

The M.P.E.P. § 803, states:

> If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Thus, in view of the M.P.E.P. § 803, Applicants respectfully request that the claims of Groups I thru IV be searched and examined in the captioned application.

Should the Examiner find the above argument unpersuasive, Applicants respectfully request that, at the very least, Groups I and II be rejoined. In the Office Action, pages 3-4, the Examiner alleges that Groups I and II are independent inventions and, thus, patentably distinct. The Examiner states that "in the instant case, the different inventions have different functions and are not disclosed as capable of being used together." Applicants submit that Groups I and II have been disclosed as capable of being used together and, as a result, are not distinct inventions. For example, in example 2, Applicants utilize an ARS to generate a strain of *Candida famata*, L20105 (NRRL deposit number Y-30292), which has enhanced transformation frequency. Applicants submit that the enhanced transformation frequency of the L20105 strain allowed for the generation of *Candida famata leu2 rib1* mutants (example 5), which were used to isolate and purify yeast cells from Group II. Thus, Group II is directed towards yeast mutants generated using yeast strains in Group I as the parental strain. As a result, Applicants have a method for using Groups I and II together and, therefor, Applicants submit that Groups I and II should be rejoined.

Applicants submit that the application is fully in condition for examination. An examination on the merits is earnestly solicited.

Respectfully submitted,

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